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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,083	10/04/2000	Robert Bernstein	79540	7763

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office-Action Summary

Application No.

09/679,083

Applicant(s)

BERNSTEIN, ROBERT

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taricani, Jr (US Patent No. 6,347,304) in view of Davis et al (US Patent No. 6,078,898).

As per claims 1, Taricani Jr, discloses a computer-programmed system for recovering tax revenue. The system comprises:

Transferring a summary of the transaction from a seller of the transaction to a secure database (column 8, lines 27-45 and column 12, lines 20-30);

Identifying a subject of the transaction (column 9, lines 20-33);

Taricani Jr does not explicitly teach transferring a summary of the transaction from a buyer of the transaction to the secure database. Davis et al disclose a system for collecting taxes made on a transaction. Users of the system of Davis et al use a portable storage device denoted as SSDD 5 for accumulating transactions. Transaction summaries are transmitted to a network of computers and or a tax server for determining a tax rate. Note column 6, lines 5-8 and lines 16-18 of Davis et al. Applicant is also referred to column 7, lines 8-37 and 55-61 of Davis et al.

As per the step of determining a local of the buyer and the seller to the transaction see (column 6, lines 55-63; column 7, lines 23-29 of Taricani, Jr. and ;column 2, lines 45-49, column 6, lines 44-49 of Davis et al.).

Calculating a tax due based upon the identified matter and determined local of the buyer and seller (column 3, lines 45-52, column 7, lines 18-29 of Taricani Jr and column 5, lines 20-22, column 6, lines 5-9 and column 10, lines 1-2 of Davis et al.

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Davis et al into the teachings of Taricani Jr. in order to have the recorded transactions from both buyers and sellers so as to compare the two records in order to ascertain whether or not a tax was paid by the buyer and the collected revenue was not transmitted by the seller. In so doing, the taxing authority would have easily recognized which party to bill and or the correct amount to bill the appropriate party.

As per claim 2, Taricani Jr discloses transferring the summary by coupling to a third party using T1 or T3 lines. Note figure 3 and column 8, lines 33-45 and column 5, lines 14-28 of Taricani Jr. Applicant is also referred to column 2, lines 58-60 of Davis et al.

As per claim 3, Davis et al. disclose the summary includes an identifier of the buyer and seller in the summary transferred from the buyer. Note column 6, lines 51-61 of Davis et al. The seller ID would have been presented in the transaction receipt or summary because the buyer pays the transaction amount to the seller.

As per claim 4, Taricani Jr. further discloses including an identifier of the buyer and seller in the summary transferred from the seller. Note column 4, lines 24-29 and column 9, lines 20-42 of Taricani Jr.

As per claims 6 and 7, the summary of the transaction would have included a zipcode of both buyers and sellers since the combined teachings of Taricani Jr and Davis et al include out of state sellers and performing interstate transactions. See column 6, lines 44-49 and column 2, lines 45-49 of Davis et al. and column 8, lines 9-13 of Taricani Jr. and column 6, lines 44-49 of Davis et al.

As per claim 8, correlating the zipcode of the buyer and the zipcode of the seller to respective locals through look-up table would have been obvious to one of ordinary skill in the art in the combination of Taricani Jr and Davis et al in order to note where the transactions take place and which tax jurisdictions or authorities are entitled to the collected tax revenue.

As per claim 9, taxes are usually due quarterly, semi-annually or annually as determined by a plurality of taxing authorities. Forwarding from the third party to the seller a quarterly summary of calculated taxes due from the seller would have been obvious to one of ordinary skill in the art in the combination of Taricani Jr and Davis et al in order to remind sellers of their obligation to pay the required taxes involving a sales or financial transaction.

Claims 10-18 and 19-27 contain limitations recited in respective claims 1-9 and they are likewise rejected. Furthermore, claims 10-18 and 19-27 are apparatus claims reciting means or computer subsystems for performing recited in respective claims 1-9. It should be noted that the combination of Taricani Jr and Davis et al is directed toward a computer system for recovering taxes and comprises means and an apparatus having a plurality of devices connected over a network for performing the functions recited in claims 1-9.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-9

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do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-9 are rejected as being directed to non-statutory subject matter.

Conclusion


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) (872-9327).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

December 8, 2003


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628